

REMARKS

Claims 1-32 are pending in the present application.

Claims 1-10, 31, and 32 are hereby withdrawn.

Claims 11 and 21 stand rejected under 35 U.S.C. § 112, second paragraph.

Claims 11-30 stand rejected under 35 U.S.C. § 103(a) over Lupien et al., U.S. Patent No. 6,098,051 (“*Lupien*”) in view of Official Notice.

Applicant respectfully submits that all of Applicant’s arguments are without *prejudice* or *disclaimer*. In addition, Applicant has merely discussed example distinctions from the cited prior art. Other distinctions may exist, and as such, Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. Applicant further respectfully submits that by not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicant are considered sufficient to overcome the Examiner's rejections.

REJECTION UNDER 35 U.S.C. § 112:

Claims 11 and 21 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regard as the invention. Applicant respectfully disagrees. In particular the Examiner states:

The *claims are generally narrative and indefinite, failing to conform with current U.S. practice*. They appear to be a literal translation into English from a foreign document and are *replete with grammatical and idiomatic errors*. For example, but not limited to, independent claim 11 and 21 and their dependent claims are rejected as they are describing a graph.

(18 March 2008 Office Action, page 2). (Emphasis added). Applicant respectfully requests clarification from the Examiner to any objection or rejection regarding Applicant’s claims. For example, Applicant respectfully requests the Examiner to point to Applicant’s claims that “*fail*”

to conform with current U.S. practice” and to point out these alleged “*grammatical and idiomatic errors*”, as asserted by the Examiner. (18 March 2008 Office Action, page 2). (Emphasis added).

In addition, the Examiner states:

The term "substantially vertical" in claim 11 and 21 is a relative term which renders the claim indefinite. The term "substantially vertical" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For the purpose of the examination, the examiner interprets "substantially vertical" as "vertical".

The term "substantially perpendicular" in claim 11 and 21 is a relative term which renders the claim indefinite. The term "substantially vertical" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For the purpose of the examination, the examiner interprets "substantially perpendicular" as "perpendicular".

(18 March 2008 Office Action, pages 2-3). (Emphasis added). Applicant does not understand why the term “substantially” is thought to “render[] the claim indefinite” and respectfully requests further explanation from the Examiner. The Examiner may call the undersigned, Steven J. Laureanti, at (480) 830-2700 if the Examiner believes it would be easier to discuss the term “substantially” over the telephone.

In addition, Applicant conducted a search on the United States Patent and Trademark website in which the term “substantially” is used in claims. The search revealed that 905,251 patents have issued in the United States between 1976 and the present. Applicant respectfully requests the Examiner to cite a specific rule in 37 C.F.R. or in the MPEP that restricts the use of the term “substantially” in a claim. Again the Examiner may call the undersigned, Steven J. Laureanti, at (480) 830-2700 if the Examiner believes it would be easier to discuss the term “optimal” over the telephone.

In addition, Applicant respectfully requests that the Examiner call the undersigned at (480) 830-2700, if the Examiner has additional comments or suggestions to the 35 U.S.C. § 112

rejection of the subject Application or if the Examiner believes it would be easier to discuss the 35 U.S.C. § 112 rejection over the telephone.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 11-30 stand rejected under 35 U.S.C. § 103(a) over *Lupien* in view of Official Notice.

Applicant respectfully submits that the proposed combination of *Lupien* and the Examiner's Official Notice fails to disclose each and every limitation recited by Claims 11-30. Applicant further respectfully submits that Claims 11-30 patentably distinguish over *Lupien* or the Examiner's Official Notice, either individually or in combination. Thus, Applicant respectfully traverses the Examiner's rejection of Claims 11-30 under 35 U.S.C. § 103(a) over *Lupien* or the Examiner's Official Notice, either individually or in combination.

***Lupien* Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Claims**

For example, with respect to independent Claim 11, this claim recites:

A method for displaying strikes between bids and asks in a market over time, each strike specifying values for a plurality of strike variables, the method comprising:

receiving data for a plurality of strikes, the data reflecting values specified in the strikes for a plurality of strike variables; and

generating a display of the received data, the display comprising:

a plurality of polygons, *each polygon representing a strike between a bid and an ask*, each *polygon comprising first and second contiguous parallelograms* each associated with one or more different strike variables, *a first dimension of the first parallelogram reflecting a first value specified in the represented strike for a first strike variable, a second dimension of the first parallelogram reflecting a second value specified in the represented strike for a second strike variable, a first dimension of the second parallelogram reflecting a third value specified in the represented strike for a third strike variable, and a second dimension of the second parallelogram reflecting a fourth value specified in the represented strike for a fourth strike variable;*

a strike variable axis representing a range of values for an additional strike variable for which no value is reflected in the parallelograms, wherein the strike variable axis is substantially vertical and each polygon is positioned with respect to the strike variable axis according to the value specified in the represented strike for the additional strike variable represented by the strike variable axis; and

a time axis that is substantially perpendicular to the strike variable axis, each polygon being positioned with respect to the time axis according to a time at which the represented strike occurred.

(Emphasis added). In addition, *Lupien* fails to disclose each and every limitation of independent Claim 21.

Applicant respectfully submits that *Lupien* fails to disclose, teach, or suggest independent Claim 1 limitations regarding a “*method for displaying strikes between bids and asks in a market over time*, each strike specifying values for a plurality of strike variables” and in particular *Lupien* fails to disclose, teach, or suggest independent Claim 1 limitations regarding a “plurality of polygons, *each polygon representing a strike between a bid and an ask*, each *polygon comprising first and second contiguous parallelograms* each associated with one or more different strike variables, *a first dimension of the first parallelogram reflecting a first value specified in the represented strike for a first strike variable*, *a second dimension of the first parallelogram reflecting a second value specified in the represented strike for a second strike variable*, *a first dimension of the second parallelogram reflecting a third value specified in the represented strike for a third strike variable*, and *a second dimension of the second parallelogram reflecting a fourth value specified in the represented strike for a fourth strike variable*”. In particular, the Examiner states:

a plurality of polygons, each polygon representing a strike between a bid and an ask (see abstract, column 4, lines 27-48 and column 12, lines 31-37, where "matches buy and sell orders" of abstract is equivalent of "a strike between a bid and an ask"), each polygon comprising first and second of contiguous parallelograms each associated with one or more different strike variables (see Fig. 2, Figs. 6-7 and Figs. 9A-9B, and column 10, lines 53-64, where "square" is equivalent of "parallelogram"), a first and second contiguous parallelograms, a first dimension of the first parallelogram reflecting a first value specified in the represented strike for a first strike variable, a second dimension of the first parallelogram reflecting a second value specified in the represented strike for a second strike variable, a first dimension of the second parallelogram reflecting a third value specified in the represented strike for a third strike variable, and a second dimension of the second parallelogram reflecting a fourth value specified in the represented strike for a fourth strike variable (see *Lupien*, Fig. 2, Figs. 6-7 and Figs. 9A-9B);

(18 March 2008 Office Action, page 4). (Emphasis added). By contrast, the cited portion of *Lupien* on which the Examiner relies does not disclose “plurality of polygons, *each polygon representing a*

strike between a bid and an ask, each polygon comprising first and second contiguous parallelograms each associated with one or more different strike variables, a first dimension of the first parallelogram reflecting a first value specified in the represented strike for a first strike variable, a second dimension of the first parallelogram reflecting a second value specified in the represented strike for a second strike variable, a first dimension of the second parallelogram reflecting a third value specified in the represented strike for a third strike variable, and a second dimension of the second parallelogram reflecting a fourth value specified in the represented strike for a fourth strike variable.”

The Office Action Acknowledges that *Lupien* Fails to Disclose Various Limitations Recited in Applicants Claims

Applicant respectfully submits that the Office Action acknowledges, and Applicant agrees, that *Lupien* fails to disclose various limitations recited in independent Claim 1. In particular the Examiner acknowledges that *Lupien* fails to:

Examiner takes Official Notice that the following three limitations of Claim 11 recite about the display of data in the form of a graph that have been well-known for decades, and were already utilized by at least the inventions of streetprices.com and pricegrabber.com prior to the date of invention claimed by the instant application. It would have been obvious to an ordinary person of skill in the art at the time invention was made to modify the teachings of Lupien et al. With the knowledge of a 'graph' to permit Lupien's display of data results to be modified in the form of a 'graph' for displaying values. The motivation to combine these references would be to provide a more timely, and efficient system and method for searching and displaying data information meeting the search criteria to make an informed decision by a user.

(18 March 2008 Office Action, pages 3-4). (Emphasis added). However, the Examiner asserts Official Notice over the acknowledged shortcomings in *Lupien*. Applicants respectfully traverse the Examiner's assertion of Official Notice. In addition, the *“three limitations of Claim 11”* that the Examiner states that *Lupien* fails to disclose are:

a plurality of polygons, *each polygon representing a strike between a bid and an ask*, each *polygon comprising first and second contiguous parallelograms* each associated with one or more different strike variables, *a first dimension of the first parallelogram reflecting a first value specified in the represented strike for a first strike variable, a second dimension of the first parallelogram reflecting a second value specified in the represented strike for a*

second strike variable, a first dimension of the second parallelogram reflecting a third value specified in the represented strike for a third strike variable, and a second dimension of the second parallelogram reflecting a fourth value specified in the represented strike for a fourth strike variable;

a strike variable axis representing a range of values for an additional strike variable for which no value is reflected in the parallelograms, wherein the strike variable axis is substantially vertical and each polygon is positioned with respect to the strike variable axis according to the value specified in the represented strike for the additional strike variable represented by the strike variable axis; and

a time axis that is substantially perpendicular to the strike variable axis, each polygon being positioned with respect to the time axis according to a time at which the represented strike occurred.

(18 March 2008 Office Action, pages 3-4). Applicant respectfully submits that the Office Action fails to properly establish a *prima facie* case of obviousness over independent Claim 11 and in particular, over the “*three limitations of Claim 11*” that the Examiner acknowledges are not disclosed in *Lupien*. Thus, Applicants respectfully submits that the equations forming the foundation of the Examiner’s comparison between *Lupien* and independent Claim 11 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish independent Claim 11 from *Lupien*.

The Proposed *Lupien*-Official-Notice Combination is Improper Under MPEP § 706.02(j)

Applicant respectfully submits that the rejection of Claims 11-30 is improper under 35 U.S.C. § 103(a) over *Lupien* in view of the Examiner’s Official Notice, because the Examiner’s initial burden of proof has not been satisfied. In addition, Applicant respectfully traverses the rejection of Claims 11-30 because the Examiner has not properly complied with MPEP § 706.02(j).

After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action:

(A) the relevant teachings of the prior art relied upon, preferably with *reference to the relevant column* or page number(s) *and line number(s) where appropriate*,

(B) the difference or *differences in the claim over the applied reference(s)*,

(C) the *proposed modification of the applied reference(s)* necessary to arrive at the claimed subject matter, and

(D) an *explanation why one of ordinary skill* in the art at the time the invention was made *would have been motivated to make the proposed modification*. (MPEP § 706.02(j)). (Emphasis Added).

Applicant further respectfully submits that the Examiner has not set forth: (1) asserted any argument or remarks regarding the differences in the Applicant's claims over *Lupien*; (2) asserted any proposed modifications of *Lupien* to arrive at the Applicant's claimed invention; or (3) asserted any explanation why one of ordinary skill would have been motivated to make the proposed modifications. In addition to failing to comply with the above MPEP requirements, the Examiner has also failed to establish a *prima facie* case of obviousness based on the three basic requirements set forth in MPEP § 706.02(j). First, there must be some suggestion or motivation, either in *Lupien* or the Examiner's Official Notice, or in the knowledge generally available to one of ordinary skill in the art, to modify *Lupien*. Second, there must be a reasonable expectation of success. Finally, *Lupien* or the Examiner's Official Notice, either individually or in combination, must teach or suggest all the Applicant's claim limitations. ***The teaching or suggestion*** to make the *Lupien* and the Examiner's Official Notice combination and the ***reasonable expectation*** of success ***must both be found in Lupien or the Examiner's Official Notice and not based on Applicants disclosure***. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis Added).

Applicant still further respectfully submits that the MPEP clearly states that the "initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done." (MPEP § 706.02(j)). "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). In the subject Application, ***the Examiner has not shown the Applicant's claimed invention to be expressly or impliedly suggested in Lupien or the Examiner's Official Notice nor has the Examiner presented a convincing line of reasoning***, let alone any reasoning, why the artisan would have found the Applicant's claimed invention to be obvious in view of *Lupien* or the Examiner's Official Notice.

The MPEP further states that “it is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply.” (MPEP § 706.02(j)). Thus, if the Examiner continues to maintain the rejection to Claims 11-30 under 35 U.S.C. § 103(a) based on the proposed combination of *Lupien* and the Examiner’s Official Notice, ***Applicant respectfully requests that the Examiner provide a proper argument in support of the Examiner’s rejection, as necessitated by MPEP § 706.02(j).***

For at least the reasons set forth herein, Applicant respectfully requests that the rejection of Claims 11-30 under 35 U.S.C. § 103(a) be reconsidered and that Claims 11-30 be allowed.

The Examiner’s Official-Notice is improper under MPEP § 2144.03

Applicant respectfully submits that Applicant is confused as to what the Examiner teaches by the Official Notice or even to the extent in which the Examiner is taking Official Notice. Applicant respectfully requests clarification as to the subject matter for which Official Notice is being taken. ***Applicant respectfully traverses the Official Notice because the asserted facts***, as best understood by Applicant, ***are not supported by substantial documentary evidence or any type of documentary evidence*** and appear to be the Examiner’s opinions formulated using the subject Application as a template, which constitutes impermissible use of hindsight. Furthermore, under these circumstances, it is inappropriate for the Examiner to take Official Notice without documentary evidence to support the Examiner’s conclusion. (See MPEP § 2144.03). ***Applicant respectfully requests the Examiner to produce authority for the Examiner’s Official Notice.***

Only “in limited circumstances,” is it “appropriate for an examiner to take official notice of facts not in the record or to rely on common knowledge in making a rejection”. (MPEP § 2144.03). “Official notice unsupported by documentary evidence ***should only be taken by the examiner*** where the facts asserted to be well-known, or to be common knowledge in the art are ***capable of instant and unquestionable demonstration as being well-known.***

With respect to the subject Application, the Examiner’s statement that “***Examiner takes Official Notice that the following three limitations of Claim 11 recite about the display of data in the form of a graph that have been well-known for decades***”, is not capable of instant and

unquestionable demonstration as being well-known. (18 March 2008 Office Action, pages 3-4). As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be ‘*capable of such instant and unquestionable demonstration as to defy the dispute*’ (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 U.S.P.Q. 6 (C.C.P.A. 1961)).” (MPEP § 2144.03(A)). (Emphasis Added).

“It is *never appropriate to rely solely on “common knowledge” in the art without evidentiary support in the record*, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697. As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* at 1385, 59 USPQ2d at 1697. See also *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002).” (MPEP § 2144.03(A)).

“Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that *general conclusions concerning what is “basic knowledge” or “common sense” to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection*). The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made.” (MPEP § 2144.03(B)). (Emphasis Added).

Applicant respectfully submits that the Office Action provides no documentary evidence to support the Official Notice taken by the Examiner, yet the asserted facts are not capable of “instant and unquestionable” demonstration as being well-known. Applicant further respectfully submits that Applicant has adequately traversed the Examiner’s assertion of Official Notice and directs the Examiner’s attention to the pertinent text of the MPEP, which states:

If applicant adequately traverses the examiner’s assertion of official notice, the examiner must provide documentary evidence in the next Office action if the

rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (“[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings” to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). (MPEP § 2144.03(C)).

Thus, if the Examiner continues to maintain the rejection of Claims 11-30 based on the Official Notice, Applicant respectfully requests that the Examiner provide documentary evidence as necessitated by MPEP § 2144.03(C). Furthermore, if the Examiner is relying on personal knowledge to support the finding of what is known in the art, Applicant further respectfully requests that the Examiner provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding as further necessitated by MPEP § 2144.03(C).

The Office Action Fails to Properly Establish a *Prima Facie* case of Obvious over the Proposed *Lupien*-Official-Notice Combination According to the UPSTO Examination Guidelines

Applicant respectfully submits that the Office Action fails to properly establish a *prima facie* case of obviousness based on the proposed combination of *Lupien* or the Examiner’s Official Notice, either individually or in combination, and in particular, the Office Action fails to establish a *prima facie* case of obviousness based on the “Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*” (the “Guidelines”).

As reiterated by the Supreme Court in *KSR International Co. v. Teleflex Inc.* (*KSR*), the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)). Obviousness is a question of law based on underlying factual inquiries. These factual inquiries enunciated by the Court are as follows:

- (1) Determining the scope and content of the prior art;
- (2) Ascertaining the differences between the claimed invention and the prior art; and
- (3) Resolving the level of ordinary skill in the pertinent art.

(Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). Objective evidence relevant to the issue of obviousness must be evaluated by Office personnel. (383 U.S. 17–18, 148 USPQ 467 (1966)). As stated by the Supreme Court in *KSR*, “While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.” (*KSR*, 550 U.S. at ___, 82 USPQ2d at 1391).

However, it is important to note that the Guidelines require that Office personnel “***ensure that the written record includes findings of fact*** concerning the state of the art and the teachings of the references applied. (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). In addition, the Guidelines remind Office personnel that the “***factual findings made by Office personnel are the necessary underpinnings to establish obviousness.***” (*id.*). Further, “***Office personnel must provide an explanation to support an obviousness rejection*** under 35 U.S.C. 103. (*id.*). In fact, “35 U.S.C. 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed” and “clearly setting forth findings of fact and the rationale(s) to support a rejection in an Office action leads to the prompt resolution of issues pertinent to patentability.” (*id.*).

With respect to the subject application, the Office Action has not shown the ***factual findings necessary to establish obviousness*** or even ***an explanation to support the obviousness rejection*** based on the proposed combination of *Lupien* and the Examiner’s Official Notice. The Office Action merely states that “it would have been obvious to an ordinary person of skill in the art at the time invention was made to modify the teachings of *Lupien et al.* With [sic] the knowledge of a ‘graph’ to permit *Lupien*’s display of data results to be modified in the form of a ‘graph’ for displaying values.” (18 March 2008 Office Action, pages 3-4). Applicant respectfully disagrees and respectfully submits that the Examiner’s conclusory statement is not sufficient to establish the ***factual findings necessary to establish obviousness*** and is not a sufficient ***explanation to support the obviousness rejection*** based on the proposed combination of *Lupien* and the Examiner’s Official Notice.

The Guidelines further provide guidance to Office personnel in “determining the scope and content of the prior art” such as, for example, “Office personnel must first obtain a thorough understanding of the invention disclosed and claimed in the application.” (Notice, 72 Fed. Reg.

57527 (Oct. 10, 2007)). The scope of the claimed invention must be clearly determined by giving the claims the “broadest reasonable interpretation consistent with the specification.” (See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) and MPEP § 2111.). In addition, the Guidelines state that any “***obviousness rejection should include***, either explicitly or implicitly in view of the prior art applied, ***an indication of the level of ordinary skill.***” (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). With respect to the subject Application, the Office Action has not provided ***an indication of the level of ordinary skill.***

The Guidelines still further provide that once the *Graham* factual inquiries are resolved, Office personnel must determine whether the claimed invention would have been obvious to one of ordinary skill in the art. (*Id.*). For example, the Guidelines state that ***Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.*** (*Id.*). In addition, the Guidelines state that the proper analysis is ***whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts.*** (*Id.* and See 35 U.S.C. 103(a)).

With respect to the subject Application, the Office Action has not expressly resolved any of the *Graham* factual inquiries to determine whether Applicant invention would have been obvious to one of ordinary skill in the art. In addition, the Office Action fails to ***explain why the difference(s) between the proposed combination of Lupien, the Examiner’s Official Notice and Applicant’s claimed invention would have been obvious to one of ordinary skill in the art.*** The Office Action merely states that “motivation to combine these references [*Lupien* and the knowledge of a ‘graph’] would be to provide a more timely, and efficient system and method for searching and displaying data information meeting the search criteria to make an informed decision by a user.” (18 March 2008 Office Action, pages 3-4). Applicant respectfully disagree and further respectfully request clarification as to how this statement ***explains why the difference(s) between the proposed combination of Lupien, the Examiner’s Official Notice and Applicant’s claimed invention would have been obvious to one of ordinary skill in the art.*** Applicant further respectfully submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

The Guidelines yet further state that the “key to supporting any rejection under 35 U.S.C. 103 is the *clear articulation of the reason(s) why the claimed invention would have been obvious.*” (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). In fact, the Supreme Court in *KSR* noted that “*the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.*” (*id.*). The Court quoting *In re Kahn* (441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)), stated that “[R]ejections on *obviousness cannot be sustained by mere conclusory statements*; instead, there *must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.*” (*KSR*, 550 U.S. at ___, 82 USPQ2d at 1396). The Guidelines provide the following seven rationales:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Applicant respectfully submits that the *Office Action fails to provide any articulation, let alone, clear articulation of the reasons why Applicant’s claimed invention would have been obvious.* For example, the *Examiner has not adequately supported the selection and combination of Lupien and the Examiner’s Official Notice to render obvious Applicant’s claimed invention.* The Examiner’s unsupported conclusory statements that “it would have been obvious to an ordinary person of skill in the art at the time invention was made to modify the teachings of Lupien et al. With [sic] the knowledge of a ‘graph’ to permit Lupien’s display of data results to be modified in the form of a ‘graph’ for displaying values” and the “motivation to combine these references [Lupien and the knowledge of a ‘graph’] would be to provide a more timely, and efficient system

and method for searching and displaying data information meeting the search criteria to make an informed decision by a user”, *does not adequately provide clear articulation of the reasons why Applicant’s claimed invention would have been obvious*. (18 March 2008 Office Action, pages 3-4). In addition, the Examiner’s unsupported conclusory statement fails to meet any of the Guidelines rationales to render obvious Applicant claimed invention.

Thus, if the Examiner continues to maintain the obvious rejection based on the proposed combination of *Lupien* and the Examiner’s Official Notice, *Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including a statement by the Examiner identifying which one of the seven rationales the Examiner is relying on and the proper analysis of that particular rationale, as required by the Guidelines*.

Applicant’s Claims are Patentable over the Proposed *Lupien*-Official-Notice Combination

Applicant respectfully submits that independent Claim 11 is considered patentably distinguishable over the proposed combination of *Lupien* and the Examiner’s Official Notice. This being the case, independent Claim 21 is also considered patentably distinguishable over the proposed combination of *Lupien* and the Examiner’s Official Notice for at least the reasons discussed above in connection with independent Claim 11.

Furthermore, with respect to dependent Claims 12-20 and 22-30: Claims 12-20 depend from independent Claim 11 and Claims 22-30 depend from independent Claim 21, and are also considered patentably distinguishable over the proposed combination of *Lupien* and the Examiner’s Official Notice. Thus, dependent Claims 12-20 and 22-30 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

Thus, for at least the reasons set forth herein, Applicant respectfully submits that Claims 11-30 are not rendered obvious by the proposed combination of *Lupien* and the Examiner’s Official Notice. Applicant further respectfully submits that Claims 11-30 are in condition for allowance. Thus, Applicant respectfully requests that the rejection of Claims 11-30 under 35 U.S.C. § 102(b) be reconsidered and that Claims 11-30 be allowed.

CONCLUSION:

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although Applicant believes no additional fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

18 June 2008
Date

/Steven J. Laureanti/signed
Steven J. Laureanti, Registration No. 50,274

BOOTH UDALL, PLC
1155 W. Rio Salado Parkway, Ste. 101
Tempe AZ, 85281
214.636.0799 (mobile)
480.830.2700 (office)
480.830.2717 (fax)
steven@boothudall.com

CUSTOMER NO. 53184